

Applicants : Hiromi Watanabe and Isao Kuwahara
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REMARKS

In the Office Action, the Examiner rejected claims 24-99 under 35 U.S.C. § 112, second paragraph, as being indefinite inasmuch as the Examiner thought it was unclear what the term "compatibly expansile" means. This is defined in the specification on page 12, beginning on line 24, where it is stated that compatibly expansile ink 14 well follows the expansion of the low density polyethylene film 12 without obstructing such expansion such that, as further stated, with the compatibly expansile ink 14, said surface of the film 12 remains smooth and substantially free from a touch of irregularity. This allows, as noted on top of page 13, that relatively large areas of the thermally insulated cup to be printed. Thus, although it is assumed that the terminology provided is clear as originally presented, independent claims 24 and 45 have been amended to define that the ink follows the expansion of said low melting point thermoplastic film and is applied on an outer surface of the film. The term "compatibly expansile" has been deleted from the remaining claims.

Claims 73-80 were rejected under 35 U.S.C. § 112 with the Examiner questioning whether a medium polyethylene meant medium density polyethylene. The Examiner is correct and the term "density" has been added to define the intended language of these claims.

Finally, claims 27 and 49 were rejected under 35 U.S.C. § 112 because the Examiner was not clear what the term "indicia" means. Indicia, as shown by the dictionary definition enclosed herewith as Exhibit A, can be any marking which is applied to an object. It is frequently used in connection with items which are printed in the patent art as, for example, in the plant tag area, as shown by the enclosed U.S. Patent No. 4,972,616 (Exhibit B). Thus, the term "indicia" as used herein and particularly as used in claims 27 and 49 means a marking printed on the outer surface of the existing printed ink.

In the Office Action, claims 24-99 were also rejected under 35 U.S.C. § 102(b) as being anticipated by Iioka et al. (U.S. Patent 5,490,631). Applicants respectfully traverse this rejection and requests reconsideration for the following reasons. For a prior art reference to anticipate under 35 U.S.C. § 102 every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). Initially, it is noted that

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independent claims 24 and 45 each define three elements not found in Iioka et al., namely, the high melting point thermoplastic resin film laminated on the inner wall surface of the base paper, a low melting point thermoplastic resin film laminated on the outer wall surface of the base paper, and ink, which follows the expansion of the low melting point thermoplastic film, which is applied to the outer surface of the low melting point thermoplastic resin film. Iioka et al., on the other hand, teaches a paper cup with a low density film on the outer surface (column 6, line 14) and a medium or high density film on the inner surface (column 6, lines 15-16) without regard to the melting point of a thermoplastic material. Further, ink in the Iioka et al. patent is printed directly on the paper body member 3 in area 9 as taught in column 3, lines 29-31 and column 4, lines 14-16.

Independent claims 24 and 45 of the present invention specifically call for a layer of ink to be applied to the outer surface of the low melting point thermoplastic resin film. The advantages discussed in the background and summary of the invention are not shown or suggested by the Iioka et al. patent. Accordingly, the rejection under 35 U.S.C. § 102(b) is respectfully traversed and reconsideration is requested.

By this Amendment, it is submitted that this application defines patentable subject matter and is in condition for allowance, which action is respectfully requested.

Respectfully submitted,

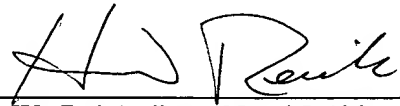
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APPENDIX A
Version With Markings to Show Changes Made

24. (amended) Stock material for a container body of an insulating paper container, said stock material comprising:

base paper;

a high m.p. thermoplastic synthetic resin film laminated on the inner wall surface of said base paper;

a low m.p. thermoplastic synthetic resin film laminated on the outer wall surface of said base paper wherein said low m.p. thermoplastic synthetic resin film is expandable by heat treatment; and

~~[a compatibly expansile]~~ ink, which follows the expansion of said low m.p. thermoplastic film, is applied on an outer surface of said low m.p. thermoplastic synthetic resin film.

25. (amended) Stock material according to claim 24, wherein said ~~[compatibly expansile]~~ ink is applied on the upper surface of the low m.p. thermoplastic synthetic resin film being expandable by heat treatment as a primer.

26. (amended) The stock material according to claim 25, wherein said ~~[compatibly expansile]~~ ink applied as said primer is white.

27. (amended) The stock material according to claim 24, wherein the outer surface of said ~~[compatibly expansile]~~ ink is printed with indicia using separately prepared ~~[compatibly expansile]~~ ink.

28. (amended) The stock material according to claim 25, wherein the outer surface of said ~~[compatibly expansile]~~ ink is printed with indicia using separately prepared ~~[compatibly expansile]~~ ink.

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29. (amended) The stock material according to claim 26, wherein the outer surface of said ~~[compatibly-expansile]~~ ink is printed with indicia using separately prepared ~~[compatibly-expansile]~~ ink.

45. (amended) An insulating paper container generally comprising a container body and a bottom wall, said insulating paper container further comprising:

a high m.p. thermoplastic synthetic resin film laminated on the inner wall surface of a base paper for said container body and said bottom wall;

a low m.p. thermoplastic synthetic resin film laminated on the outer wall surface of said base paper for said container body;

~~[a-compatibly-expansile]~~ ink, which follows the expansion of said low m.p. thermoplastic resin film, is applied on the outer surface of said low m.p. thermoplastic synthetic resin film so that said ink may follow expansion of said low m.p. thermoplastic synthetic resin film; and

wherein said low m.p. thermoplastic synthetic resin film is expanded by subjecting the lamination to heating treatment.

46. (amended) The insulating paper container according to claim 45, wherein the upper surface of the low m.p. thermoplastic synthetic resin film being expandable by heating treatment is applied with said ~~[compatibly-expansile]~~ ink as primer.

47. (amended) The insulating paper container according to claim 46, wherein said ~~[compatibly-expansile]~~ ink applied as said primer is white.

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48. (amended) The insulating paper container according to claim 45, wherein the upper surface of said [~~compatibly expansile~~] ink is printed with indicia using separately prepared [~~compatibly expansile~~] ink.

49. (amended) The insulating paper container according to claim 46, wherein the upper surface of said [~~compatibly expansile~~] ink is printed with indicia using separately prepared [~~compatibly expansile~~] ink.

50. (amended) The insulating paper container according to claim 47, wherein the upper surface of said [~~compatibly expansile~~] ink is printed with indicia using separately prepared [~~compatibly expansile~~] ink.

73. (amended) The insulating paper container according to claim 45, wherein the high m.p. thermoplastic synthetic resin film being unexpanded by heating treatment is made of medium density polyethylene having a MFR (melt flow rate) of 4 - 8 g/10 min.

74. (amended) The insulating paper container according to claim 46, wherein the high m.p. thermoplastic synthetic resin film being unexpanded by heating treatment is made of medium density polyethylene having a MFR (melt flow rate) of 4 - 8 g/10 min.

75. (amended) The insulating paper container according to claim 47, wherein the high m.p. thermoplastic synthetic resin film being unexpanded by heating treatment is made of medium density polyethylene having a MFR (melt flow rate) of 4 - 8 g/10 min.

76. (amended) The insulating paper container according to claim 48, wherein the high m.p. thermoplastic synthetic resin film being unexpanded by heating treatment is made of medium density polyethylene having a MFR (melt flow rate) of 4 - 8 g/10 min.

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77. (amended) The insulating paper container according to claim 51, wherein the high m.p. thermoplastic synthetic resin film being unexpanded by heating treatment is made of medium density polyethylene having a MFR (melt flow rate) of 4 - 8 g/10 min.

78. (amended) The insulating paper container according to claim 55, wherein the high m.p. thermoplastic synthetic resin film being unexpanded by heating treatment is made of medium density polyethylene having a MFR (melt flow rate) of 4 - 8 g/10 min.

79. (amended) The insulating paper container according to claim 60, wherein the high m.p. thermoplastic synthetic resin film being unexpanded by heating treatment is made of medium density polyethylene having a MFR (melt flow rate) of 4 - 8 g/10 min.

80. (amended) The insulating paper container according to claim 66, wherein the high m.p. thermoplastic synthetic resin film being unexpanded by heating treatment is made of medium density polyethylene having a MFR (melt flow rate) of 4 - 8 g/10 min.